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REMARKS

This is a response to the Office Action (MADE FINAL) dated January 6, 1994. In the Office Action, the Examiner has (1) rejected Claims 1-8 under 35 U.S.C. 112, (2) rejected Claim 11 as being drawn to an improper Markush group and (3) objected to Claims 9-10. In this response, Applicants respectfully request reconsideration of the rejections and the objection.

SECTION 112 REJECTIONS

The Examiner has rejected Claims 1-8 under 35 U.S.C. 112 for lack of enablement. The Examiner cites Ex parte Balzarini, 21 USPQ 2nd 1892 in support of the rejection. Applicants respectfully submit that the fact situation of Ex parte Balzarini is not the same as that of the present application. Firstly, contrary to the fact situation in Ex parte Balzarini, the Examiner has not provided objective support for the Examiner's assertion that one of ordinary skill in the art would doubt Applicants' assertions of utility. In the absence of such support, the Examiner must accept as accurate the Applicant's assertion of utility.

Secondly, the decision in Ex parte Balzarini relates only to method of use and pharmaceutical composition claims. The only claims pending in the present application are compound claims. The compounds of Claims 9-10 (i.e., the compounds of Examples 1 and 18, respectively) have already been found patentable by the Examiner (see Paper No. 8, page 3). Applicants assert that the compounds of Claim 11 (as amended herein) (i.e., the compounds of Examples 3, 5-7, 9-10 and 19-20) are very similar in structure to the compounds of Claims 9-10 and are also patentable. Furthermore, Applicants assert that the compounds of Claims 9-11 are representative of the narrow genus claimed in Claims 1-8 (as amended herein). Therefore, Applicants assert that Claims 1-8 (as amended herein) are also patentable.

Lastly, the Examiner has rejected Claims 1-8 under 35 U.S.C. 112 for not reciting the number of carbon atoms in each of the substituents which incorporates the term "alkyl". Applicants again assert that the carbon atom number for each of these substituents is clearly defined in the specification. However, in an effort to advance the examination of this application, Applicants have amended the claims herein to include the number of carbon atoms in each of the substituents. Support for these amendments is found in the definitions of the substituents on pages 9-11 of the specification.

In view of the above, Applicants respectfully request that the Examiner reconsider and withdraw the Section 112 rejections.

IMPROPER MARKUSH REJECTION

The Examiner has rejected Claim 11 as being an improper Markush claim for including non-elected subject matter. Claim 11 has been amended herein to exclude the non-elected compounds. Applicants reserve the right to file a divisional application claiming the subject matter of Claim 11 which has been cancelled by amendment herein.

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In view of the above, Applicants respectfully request that the Examiner reconsider and withdraw the improper Markush rejection.

OBJECTION

The Examiner has objected to Claims 9-10 as being dependent on a rejected base claim. The Examiner states that, if Claims 9 and 10 were rewritten in independent form, Claims 9 and 10 would be found allowable. Applicants repeat their previous assertion that Claims 9 and 10 are already in independent form. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the objection to Claims 9 and 10.

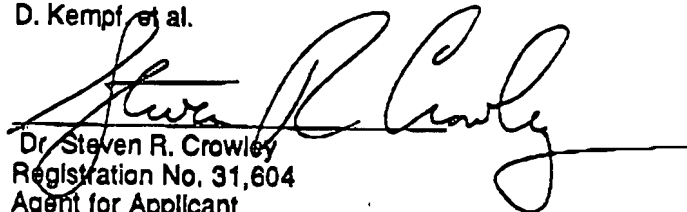
ACTION REQUESTED

In view of all of the above, Applicants respectfully request reconsideration and allowance of Claims 1-11 (as amended herein) and Claim 23 (newly added).

Alternatively, it is respectfully requested that the amendments made herein be accepted for purposes of appeal since the amendments put the claims in better form for consideration on appeal. In this regard, Applicants have enclosed herewith the Notice of Appeal.

Respectfully submitted,

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